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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Derma Sciences, Inc.

Serial No. 78127414

Wendy Boldt Cohen of Blackwell Sanders Peper Martin LLP for
Derma Sciences, Inc.

S.E. Hickey, Trademark Examining Attorney, Law Office 112
(Janice O'Lear, Managing Attorney).

Before Simms, Walters and Holtzman, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Derma Sciences, Inc. (applicant), a Missouri
corporation, has appealed from the final refusal of the
Trademark Examining Attorney to register the mark SPANGLE
for the following goods: "Bath beads, bath crystals, bath
foam, bath gel, bath oil, bath pearls, bath powder, and
non-medicated bath salts; body cream, body glitter, body
lotion, body oil, body powder and body scrubs; eye cream,
eye gel and eye shadow; face cream, face lotion, face mask,

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face powder, face toner, facial emulsions, facial glitter, facial scrubs, blush, lip balm, lip gloss and lip lotion; hair conditioner, hair gel, hair glitter, hair mascara and hair shampoo; cuticle conditioner, cuticle cream, hand cream, hand lotion, nail cream and nail polish; antibacterial soap, skin cleansing creams, skin cleansing lotions, skin cream, skin lotions, skin moisturizers, skin soap, skin texturizers and skin toners; massage oil and essential oils for personal use."¹ The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d). Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

The Examining Attorney has refused registration under Section 2(d), arguing that applicant's mark SPANGLE so resembles the registered mark PAILLETES for the following goods: "toilet soaps, perfumes, rouge, powder, lipstick, beauty-creams for the face and for the body, after shaves, bath-foams,"² that confusion is likely. In the registration, it is indicated that the mark PAILLETES is translated as "gold-dust, spangle." It is the Examining Attorney's position that there is likelihood of confusion

¹ Application Serial No. 78127414, filed May 9, 2002, based upon applicant's allegation of a bona fide intention to use the mark in commerce.

² Reg. No. 1,372,059, issued November 26, 1985, Sections 8 and 15 affidavit filed. The registration is owned by Enrico Coveri, S.R.L., an Italian joint stock company.

of applicant's mark SPANGLE with the registered mark PAILLETES, both marks used or to be used in connection with substantially identical goods, under the doctrine of foreign equivalents, because these words have the same meaning. The Examining Attorney explains that under this doctrine, an applicant may not register a foreign word if the English-language equivalent has been previously registered for similar products or services, and an applicant may not register an English word if the foreign-language equivalent has been previously registered for similar goods or services.

In addition to the translation indicated in the registration, the Examining Attorney relies on the following additional definitions of "paillette": "(a) sequin, spangle. (b) [or] speck; [mica, lessive] flake" [Webster's New World French Dictionary (1992)]; and "1. A small piece of metal or foil used in painting with enamel 2. A spangle used to ornament a dress or costume" [The American Heritage Dictionary of the English Language, Fourth Edition (2000)]. Based on these translations and definitions, she argues that consumers will translate the registered mark PAILLETES into English, as "spangle,"

which is applicant's mark.³ Also, even though "paillettes" may have more than one meaning, she argues that even if consumers translate "PAILLETES" as "sequins," that word has the same or similar meaning as the word "spangle." The Examining Attorney also maintains that identity in meaning or connotation alone is sufficient to preclude registration of applicant's mark. Because the goods here are substantially identical and otherwise closely related cosmetics and toiletry items (for example, toilet soaps, powder, lipstick, beauty creams, bath foams), the Examining Attorney maintains that less similarity of the marks is needed to support a finding of likelihood of confusion than if the goods are not as closely related.

Applicant, on the other hand, maintains that the doctrine of foreign equivalents is not an absolute rule. Rather, according to applicant, the test is whether U.S. consumers familiar with the foreign-language mark "would denote its English equivalent," brief, 2, or translate the mark into applicant's mark. It is applicant's position that the respective marks SPANGLE and PAILLETES are not

³ The Examining Attorney made this definition of "spangle" of record: "1. A small, often circular piece of sparkling metal or plastic sewn especially on garments for decoration." The American Heritage Dictionary of the English Language, Third Edition (1992).

exact equivalents and that the marks are otherwise completely different.

In this regard, applicant has pointed to various definitions of the French word "paillettes" as follows: "1. Scrap of gold that one finds in sands. 2. Small sliver of a material, more or less shiny and stiff, *mica specks, soap flakes* - small sliver of a shiny material used to decorate fabrics, certain clothing - *sequined suit of the white clown*. - pl. *Pejorative*. The world of appearances or inauthenticity. *The sequins of show business*." Le Petit Larousse Grand Format 2002. The American Heritage Dictionary of the English Language, 4th Edition (2000) indicates that "paillette" is a French word meaning "a small piece of metal or foil used in painting with enamel." The Collins French Dictionary (2002) defines "paillettes" as "sequins; spangles" and "paillette" as "speck; flake." Accordingly, it is applicant's position that where the foreign word is capable of several translations, there can be no similarity in connotation.

Applicant also argues that similarity in connotation is only one prong of the likelihood of confusion analysis, and that the mark SPANGLE, which applicant calls a "uniquely American word" (brief, 6), and the French mark

PAILLETES, are otherwise completely different in sight and sound.

Finally, applicant maintains that, especially when it comes to French marks used in connection with bath and body products, which marks are intended to refer to or suggest the allure of the French lifestyle, it is unlikely that the U.S. buyer would translate the foreign mark, but rather will take that mark as is without translating it. In sum, applicant maintains that its mark and the cited registered mark are not exact foreign equivalents, that even if registrant's mark were translated into an English word, the marks SPANGLE and PAILLETES are otherwise completely different in appearance and pronunciation, so that confusion is unlikely.

The determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973).

However, in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24,

29 (CCPA 1976). Here, since some of the goods are closely related if not identical, our focus must be on the similarity or dissimilarity of the respective marks.

Upon careful consideration of this record and the arguments of the attorneys, we agree with applicant that confusion is unlikely. First, as applicant argues, even if there were no dispute that the marks being compared are exact equivalents, it is improper to compare a foreign word mark with an English word mark solely in terms of connotation or meaning. "[S]uch similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound and all other factors, before reaching a conclusion on likelihood of confusion as to source." *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983). As the Court noted in that case, 220 USPQ at 113, "where the only similarity between marks is in connotation, a much closer approximation is necessary ... to justify a refusal to register on that basis alone where the marks otherwise are totally dissimilar." That is to say, any similarity in connotation must be weighed against dissimilarity in appearance and pronunciation as well as other factors before reaching a conclusion on the question of likelihood of confusion.

Here, applicant is correct that the French word "paillettes" is not always exactly translated as "spangle."

The definitions made of record by both applicant and the Examining Attorney demonstrate this fact. "Spangle" is not the exact equivalent of "paillettes," but "paillette" or "paillettes" may be translated into other words, such as "sequin," "speck," "flake," "gold-dust," and other multiple-word definitions such as "scrap of gold" and "small piece of metal or foil." Moreover, as applicant contends, the marks SPANGLE and PAILLETES are otherwise completely different in sound and appearance, which are factors that must be considered. See *In re Ness & Co.*, 18 USPQ2d 1815 (TTAB 1991) (GOOD-NESS and LABONTE, French for "goodness," both used on cheese, held not likely to be confused, the Board noting the dissimilarities in sound and appearance of the marks); and *In re Buckner Enterprises Corp.*, 6 USPQ2d 1316 (TTAB 1987) (PALOMA, meaning both "dove" and "pigeon," not confusingly similar to DOVE). See also *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975) (TIA MARIA not likely to be translated as "AUNT MARY" by even those familiar with Spanish).

We also note that the word "paillette" appears as an English word in English language dictionaries. See, for example, the definition of this word from the Webster's Third New International Dictionary of the English Language (Unabridged) 1993, of which we take judicial notice.

"Paillette" is defined as "1. a: one of usu. several or many small shiny objects (as spangles, sequins, beads, jewels) applied in small loosely designed clusters as a decorative trimming (as on women's clothing or accessories or on theatrical costumes) b. a trimming made of paillettes 2: a fabric (as of silk) so woven or treated as to give a shiny spangled effect." Thus, this case does not present a situation where the registered mark is only a foreign-language word which must be translated into English. The word "paillette(s)" also is an English word. This fact also provides a reason for not applying the doctrine of foreign equivalents in this case.

Accordingly, even though applicant's goods are identical or closely related to the goods in the cited registration, we conclude that confusion is unlikely under the doctrine of foreign equivalents because the marks are not exact foreign equivalents. Also, the marks SPANGLE and PAILLETES are otherwise totally dissimilar in sound and appearance.

Decision: The refusal of registration is reversed.